

III. REMARKS

In the Office Action, there was a withdrawal of the finality of the previous Office Action. Also, Claims 10-11, 18-19, 21-22, 27, 31, 35 and 39 were said to have allowable subject matter.

Objection was made to claims 2, 21-22, 26, 30, 34 and 38 for use of the acronym "SMS". The claims have been amended to overcome this objection by inclusion of the meaning (Short Message Service, as set forth on page 10 on line 5 of the specification) of the acronym in the claims.

Claims 16-17 were rejected under 35 U.S.C. 112 for lack of antecedent. Claims 16 and 17 have been amended to correct this ground of rejection.

Claims 1, 4-9, 12-13, 15-21 and 23-40 were rejected under 35 U.S.C. 102 as being anticipated by Mizikovsky (US 5,559,860) for reasons set forth in the Action. It appears that the Office Action mistakenly gave the number of the Wolff patent, but it is assumed that the examiner intended to cite the Mizikovsky patent as listed in the form PTO 892. Claims 2, 3-6, 14-17, 28, 32, 36 and 40 were rejected under 35 U.S.C. 103 as being unpatentable over Mizikovsky in view of various ones of Jambhekar (US 5,848,356), Bremer (US 6,018,671), Villa-Real (US 4,481,382), and Wolff (US 5,327,486) for reasons set forth in the Action.

The following argument is presented to overcome the rejections under 35 U.S.C. 102 and 103, thereby to secure allowance of all of the claims.

In order to distinguish the present invention from the teachings of the primary reference Mizikovsky, as well as the combination of the teachings of Mizikovsky with other ones of the cited references, the following analysis of the features of the present invention and the construction of the Mizikovsky apparatus is provided.

Mizikovsky teaches the identification of a calling party in a mobile telephone (see, for example, column 6, lines 15-18 or column 11, lines 36-40). However, it is urged that Mizikovsky does not teach an inventive feature, set forth in the present independent claims, that there is a step of sending a reply, which step is accomplished by the portable terminal. The operational alternatives which Mizikovsky gives, as following the identification of the caller, are:

- determination of the potential prioritization of the caller (column 11, lines 42-45);
- determination of the potential undesiredness of the caller (column 11, lines 45-47);
- determination of whether an accessory response has been assigned to the caller (column 11, lines 47-48);
- determination of whether a peripheral response has been assigned to the caller (column 11, lines 49-50);
- determination of whether the call in question is a long distance call (column 11, lines 50-52); or
- a regular alert (column 11, lines 56-60).

According to Mizikovsky, a priority call will cause a certain priority-indicating ringing tone to sound, or the call may be forwarded to another station. An undesired call may cause no alerts to be given or a special alert to be given (column 12,

lines 9-19). Alternatively a pre-programmed response may be activated, but Mizikovsky gives only the alternatives of activating a voice mail system or a voice recorder. In column 12, lines 27-37 Mizikovsky clearly states that the accessory device may be for example a "telephone answering machine...coupled as an accessory device to the mobile station". In other words, the mobile station or portable terminal does not accomplish the step of sending a reply by itself; it needs an auxiliary accessory device to do that.

A feature of the present invention is the exclusive use of a single terminal device to accomplish all the tasks that are required to respond to an incoming call when the user will not answer the call himself. The single terminal device identifies the caller, determines what is the correct way of handling an unanswered call from this particular identified caller and handles the call accordingly. For example, the response may be a voice message or other kind of response.

Mizikovsky discloses the steps of identifying a caller and determining the appropriate way of responding, these steps being accomplished within the terminal device itself. However, Mizikovsky fails to disclose the step of providing the actual selected response to the caller exclusively through the action of the terminal device. As noted in the Mizikovsky abstract, there is a teaching that, depending upon the response category assigned to incoming calls from a particular calling party, a selected response is initiated. The initiation of the response is not the same as providing a response to the caller exclusively via the actions of the terminal device. Mizikovsky requires numerous auxiliary devices to accomplish the actual task of responding to the caller. The Mizikovsky terminal only

initiates, to direct the call to the appropriate auxiliary device, and commands the auxiliary device to handle the call.

With reference to Fig. 1 of Mizikovsky and the respective passages in the description relating to Fig. 1, the teaching provides an accessory device or devices 50, a peripheral interface 52, a facsimile device 52a, a data processing terminal 52b, a data modem 52c, a data recorder 52d, a multimedia terminal 52e and a cartographic display 52f. In column 6 at lines 52-53, Mizikovsky clearly states that various types of accessory devices 50 may be coupled to the mobile station. It must be concluded that the terminal device, or "mobile station", in Mizikovsky is not capable of providing any caller-specific responses by itself. The Mizikovsky apparatus requires auxiliary accessory devices to accomplish its function.

An advantage of the present invention is to avoid the use of auxiliaries, and to accomplish the task of responding to an unanswered call exclusively through the action of the terminal device or mobile station itself. This feature appears in various ones of the present independent claims.

As noted in the abstract of Mizikovsky, the calling party's telephone number is compared with the stored telephone numbers, which have been previously programmed by the user, to determine a previously assigned category for direction of the response to the incoming call. In other words, all of the decision-making, in Mizikovsky, has been set into motion long before the incoming telephone call arrives. Such a feature can be provided by the teachings of the present specification, beginning at the bottom of Page 7 and continuing onto Page 8, wherein it is noted that the identity code of the calling party can be used by the user

to program the device in advance to provide the appropriate form of reply. However, this is an added feature which can be added to the basic feature of invention. The basic and novel feature of the present invention enables the portable terminal to decide which way to respond to the incoming call after learning what information, such as the identity of the calling party, is presented by the incoming call. Implementation of this feature is not possible in the system and methodology of Mizikovsky, or Mizikovsky in combination with teachings of other ones of the cited references, because they do not teach an analysis of the series of numbers appearing in a caller identification, and the generation of a response based on such analysis.

The present claims recite the feature which enables the user to select a mode of the reply subsequent to receipt of the incoming call, and emphasize the feature of enabling the portable terminal to act based only on information contained in the digits of the caller identification.

In an interview conducted with the examiner in the parent application April 10, 2000 with respect to claims having many of the limitations found in the present claims, the Examiner noted that a specific recital of the choice of modes of transmission of a reply, and the capacity to make a selection of a mode for the reply is not taught by Mizikovsky. This feature of the present invention is stated positively in the present claims, and the portable terminal is capable of performing the step of sending a reply exclusively through the action of the portable terminal. Thus, there is a recital in the present claims that the portable terminal is capable of performing the step of sending a reply exclusively through the action of the portable

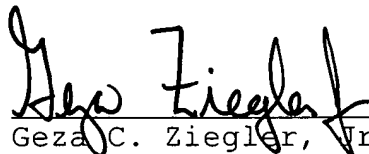
terminal, rather than by use of the external apparatus employed by Mizikovsky

It is emphasized that the present independent claims provide that both the step of identifying a caller and the step of sending a reply are accomplished within the portable terminal itself. It appears that the teachings of the cited art, considered individually or in combination, do not disclose a portable terminal that accomplishes these tasks.

For all of the foregoing reasons, it is respectfully submitted that all of the claims now present in the application are clearly novel and patentable over the prior art of record, and are in proper form for allowance. Accordingly, favorable reconsideration and allowance is respectfully requested. Should any unresolved issues remain, the Examiner is invited to call Applicants' attorney at the telephone number indicated below.

The Commissioner is hereby authorized to charge payment for any fees associated with this communication or credit any over payment to Deposit Account No. 16-1350.

Respectfully submitted,



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